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KARAWAY 01-01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Odom, et al.)
Serial No. : 09/942,520)
Filed : August 29, 2001)
For : Live And Electronic)
Wagering And Lottery Game)
Examiner : O'Neill, Michael)

Group 3713

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(Date)

Robert Ryan Morishita

Robert Ryan Morishita

APPELLANT'S BRIEF

Appellant, pursuant to 37 C.F.R. § 1.192 submits his revised brief in support of his appeal of the final rejection of all Claims 7, 8, 12, 14-28 of the above-identified application, a copy of which are provided in the Appendix.

I. Real Party in Interest

5 The present application has been assigned, in its entirety, to Karaway Gaming, a Nevada corporation having an address of 8797 East Broadway Blvd., Tucson, AZ 85710 ("Assignee").

II. Related Interferences and Appeals

There are no related interferences or appeals concerning this application. Appellant has filed an appeal for a similar refusal for a similar invention, although the applications do not have
10 a common claim of priority, in U.S. Application Serial No. 09/977,138.

III. Status of the Claims

All claims 7, 8, 12, and 14-28 pending as of the Final Office Action (Second) dated

September 2, 2004 stand finally rejected under 35 U.S.C. §103. The final rejection of the claims presented in an amendment filed April 19, 2004 (and refiled May 27, 2004) are the subject matter of this appeal.

IV. Status of Amendments

5 On February 18, 2003, Appellant submitted a response to the First Office Action (First) (dated November 12, 2002) cancelling claims 1–5 and presenting new claims 6–14. All claims were finally rejected in the Final Office Action (First) dated April 14, 2003. On July 14, 2003, Appellant filed a Response After Final Rejection amending claim 11, cancelling claim 13, re-presenting claims 6–10 and claims 12–14, and presenting new claims 15–22 so that claims 6–12
10 and 14–22 remained pending. On July 29, 2003, Examiner issued an advisory action that the new claims 15–22 would not be entered as raising new issues. On November 19, 2003, Appellant filed a Request for Continued Examination requesting entry of the amendments in the Response After Final Rejection. The amendments were entered and all pending claims 6–12 and 14–22 were rejected in the First Office Action (Second) dated February 18, 2004. On April 19,
15 2004, Appellant cancelled claims 6 and 9–11, amended claims 7, 8, 12, 14, 15, and 19, and presented new claims 23–28 so that claims 7, 8, 12, and 14 – 28 remained pending in the application. In response to a Notice of Non-Compliant Amendment, Appellant filed the same claims 7, 8, 12, and 14–28 on May 27, 2004. All claims were again finally rejected in the Final Office Action (Second) dated September 2, 2004.

20 V. Summary of the Invention

The present invention is directed to a method and electronic device for conducting a series of games using a single, finite inventory of game indicia. See p. 3, ll. 2–5. A series of games begins by randomly arranging the inventory of game indicia. See id. at p. 3, ll. 9–10. For

each game within the series of games, the player places a wager and game indicia are serially dealt from the arranged inventory. See id. at p. 3, ll. 10–12. Each game within the series of games is played to completion, that is, an outcome is reached, using the dealt game indicia. See id. at p. 3, ll. 19–22. As each game indicia is used, it is depleted, i.e. removed, from the
5 inventory such that the randomly arranged inventory is serially traversed. See id. at p. 3, ll. 5–6. At any time during the series of games, the player may view the remaining constituency of the inventory. See id. at p. 3, ll. 13–15. The player is alerted when, as a result of depletion, any particular game outcome is depleted from the universe of possible game outcomes. See id. at p. 7, ll. 11–14. The inventory may be reconstituted, that is, depleted game indicia may be
10 reintroduced and the inventory randomly rearranged, upon a player command or upon a predetermined point of exhaustion. See id. at p. 3, ll. 6–8.

A device according to the present invention includes a processor that randomly arranges a finite inventory of game indicia. See id. at p. 3, ll. 16–18. Again, the player places a wager and initiates play of the game. See id. at ll. 18–19. The processor serially displays the appropriate
15 quantity of game indicia from the inventory for each game in the series and, after use, depletes the game indicia from the inventory. See id. at p. 3, ll. 19–22. Each game results in an outcome. See id. at p. 3, l. 22–p. 4, l. 2. The processor displays the remaining constituency of the inventory and may be directed to reconstitute the inventory, i.e. reintroduce depleted game indicia and randomly rearrange the inventory, upon player command or upon a predetermined
20 exhaustion. See id. at p. 7, ll. 2–14.

VI. Issues Presented on Appeal

1. Whether Fuchs (U.S. Patent 5,630,753) in view of Kinoshita et al (U.S. Patent 5,967,894) and further in view of Richardson et al (U.S. Patent 5,042,809) renders claims 7, 8,

12, and 14–28 obvious under 35 U.S.C. section 103.

VII. Grouping of Claims

Appellant submits that the claims be grouped as follows:

Group 1

5 Claims 15, 19, 21, and 23. Appellant submits that claim 23 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

Group 2

Claims 7, 12, 16, 17, 20, 25–28. Appellant submits that claim 26 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

10 Group 3

Claims 8, 14, 18, 22, and 24. Appellant submits that claim 24 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

VIII. Argument

A. Group 1 Claims

15 1. Claim 23 is Not Rendered Obvious by Fuchs in View of Kinoshita in View of Richardson Because the References Fail to Show Depletion Across a Series of Games.

Claim 23 has been rejected as being obvious over Fuchs (U.S. Patent No. 5,630,753)
20 (hereinafter “Fuchs”) in view of Kinoshita et al (U.S. Patent 5,967,894)(hereinafter “Kinoshita”).

Claim 23 recites a method which includes selecting and displaying game indicia from an inventory of game indicia to define an outcome for a hand of play. As described in the specification the game may be Blackjack, Baccarat, Poker or the like. If the outcome is a winning outcome according to the predetermined rules of the game, the player gets an award.
25 Claim 23 also recites depleting the game indicia available for subsequent game hands and display

of the depleted inventory of game indicia (i.e., the inventory less the game indicia that have previously been selected and displayed). The example set forth in the specification for the present application is instructive of this feature.

The display 100 also, according to the present invention, displays at 118 the inventory of symbols remaining for play. For example, where there are 63 symbols, after the initial shuffle, the inventory of display would display the following:

Symbols Remaining	
Blue 7s	3
Red 7s	5
3Bars	7
2Bars	9
Bar	15
<u>Blanks</u>	<u>24</u>
Total	63

As hands or games are played, the inventory display 118 would be depleted based upon the depletion of the symbols from the serial inventory. For example, and with reference to FIG. 4, the inventory would be now shown to be the following (all 7s in FIG. 4 assumed to be Red 7s):

Symbols Remaining	
Blue 7s	3
Red 7s	2
3Bars	7
2Bars	8
Bar	10
Blanks	24

Thus as games are played the player can assess the constituency of the remaining inventory. This feature may alter the wagering decisions of the player, e.g. to increase or decrease the wagers. Specification, p. 10, ll. 3–29.

Claim 23 also recites displaying information to the player of any winning outcome eliminated by the depletion of the available data. For example, if deck depletion has eliminated

the possibility of the player obtaining three blue “7s” by, for example, depletion of all the blue “7s” from the inventory, the display would reflect this.

Claim 23 also recites the play of subsequent hands by repeating the steps of the player making a wager, the random selection and display of game indicia, judging whether the outcome is a winning or losing outcome and depleting the inventory. As set forth in the specification, for a subsequent hand the player would make another wager and play the hand using the depleted inventory. That is, in the example above, the player may play the next hand using an inventory depleted (by the play of the prior hand) from 63 game indicia to 53 game indicia.

The Examiner relies upon Fuchs as disclosing the features of claim 23. Appellant asserts that (1) Fuchs does not disclose or suggest the features of claim 37, (2) that the application of Fuchs is as a result of hindsight, (3) that Fuchs, in fact, teaches away from the claimed invention and (3) that the Examiner has not made the requisite showing of evidence for obviousness.

Fuchs discloses two games. First, Fuchs discloses a draw-type poker card game in which a player is dealt a hand of cards. Based on the cards selected to be held (as distinguished from those cards that will be discarded and replaced), a display is generated that shows a selection of the best hands that the player could form using held cards, and assuming that the cards discarded from the hand cannot be reclaimed. The cards discarded from the hand are replaced from a deck that excludes the cards already dealt to the hand. Thus, for example, if the player is dealt and discards the 2♣, the card cannot be replaced with 2♣. In this regard, the first Fuchs game is like conventional video draw poker.

Second, Fuchs discloses a slot machine game in which a stable of reel symbols is defined. The reel symbols are randomly positioned on reels and a player is allowed to hold or retain symbols for a subsequent game. Those reel symbols that “were presented in a completed first

game” are “deducted from the originally existing symbols.” Fuchs, col. 9, ll. 52–67. It is this disclosure that Examiner advances as showing “excluding from selection and display data for cards which have been selected and displayed” across a series of games as recited in the claims.

However, this is far from clear. One of ordinary skill in the art would reasonably
5 interpret Fuchs as disclosing a series of *related* slot spins in which symbols are deducted and, in this respect, analogous to the draw-type poker game of Fuchs in which cards are deducted across plays in a single hand. Fuchs states in the passage cited by Examiner that “[i]f, therefore, the player is given suggestions by the computer as to *which symbols to retain*, the player needs to know whether these suggestions are based on the game symbols originally present or whether
10 they were made on the basis of the number and type of symbols predetermined for the next game.” *Id.* at col. 9, ll. 35–41 (emphasis added). This is clearly a reference to a series of related slot spins in which a player is retaining symbols to attempt to build a winning outcome.

This is further supported by another passage cited by Examiner: “Thus, from game to game the symbols offered to the player would be deducted from the originally existing symbols,
15 if some symbols appeared or were displayed more frequently; the other symbols are therefore left over and occur in greater numbers in the following games *so that the player can adjust his game accordingly*.” *Id.* at col. 9, ll. 61–67 (emphasis added). Again, the passage “so that the player can adjust his game accordingly” simply has no meaning unless Fuchs is referring to a series of related spins. As the Board can appreciate, in a conventional slot machine, a player cannot
20 “adjust his game.” Fuchs is referring to his game in which a player can hold certain symbols for a subsequent spin.

The paragraph following this passage also supports the interpretation that (a) this is not true depletion, i.e. exclusion of symbols from play and (b) these series of spins are related.

Fuchs states that “[i]n order to ensure that an adequate number of game symbols *is available at all times*,” symbols can be added or reintroduced into the stable of symbols. *Id.* at col. 10, ll.

1–8. This disclosure would inform one of ordinary skill in the art that symbols are never truly depleted but are cycled through the system to maintain an “adequate number of game symbols.”

5 One can postulate that the quantities of symbols will fluctuate, but no symbol is ever truly excluded from play as recited in the claims. This, also supports Appellant’s interpretation that the spins are interrelated and, therefore, form a single hand. It only makes sense that if a player is “spinning and holding and spinning and holding ...” that additional symbols would need to be injected to the stable to prevent the player from eventually winnowing the stable down to the
10 desired winning combination. Rather than showing a series of independent trials each based on a continuously depleting deck of cards as recited in the claims, Fuchs shows conduct of a single hand played in multiple phases based on a pattern of holding, and spinning, and holding, and spinning, *et cetera*.

Significantly, Fuchs draws a distinction between “next game” and “new game.” *Id.* at
15 col. 9, ll. 41–46. As suggested above, by “next game” Fuchs means the next spin in a hand after having the opportunity to hold symbols. By “new game” Fuchs means the *end* of the hand and restarting the cycle of holding and spinning anew with “game symbols originally present.”

Appellant also makes two additional observations about Fuchs and its disclosure. First, Fuchs is a U.S. patent that claims priority, through the Patent Cooperation Treaty, to an Austrian
20 application. The original German-language application was published under the Patent Cooperation Treaty. In the original disclosure, Fuchs uses the phrase “nächste Spiel” which could be translated as either “next game” or “next play.” Appellant does not assert that this is conclusive of the matter, but submits that the mere use of the word “game” is not as conclusive

as Examiner would assert. Examiner takes issue with Appellant's argument of impermissible hindsight. Appellant does not impugn Examiner's analytical ability by this argument. Rather, Appellant wishes to highlight that Examiner has given meaning to the word "game" based on the teachings of Appellant's disclosure rather than the context of Fuchs. By looking at Fuchs on its own terms, rather than in light of Appellant's disclosure, the word "game" can be placed in its context as a step in an overall hand, rather than a separate and independent trial.

More specifically, Fuchs teaches that depletion only occurs between the initial deal and the deal of replacements for any non-held symbols.¹ It is respectfully submitted that Fuchs does not teach depletion over a series of hands, e.g. through a series of outcomes. It is true that Fuchs does state:

¹ "... **in the next game or section of the game** the player the player is offered by the computer unit, according to randomizing criteria or arbitrary predetermined criteria, game symbols taken from the large number of predetermined or **still available game symbols to replace the non-selected or non-stored game symbols.**" Col. 1, lines 33 - 37

"... and the said combinations of game symbols are given or are perhaps attainable in the next game or next section of the game, using the game symbols offered or available, or using the **game symbols ... stored by the player ... for the next game or the next section of the game**". Col. 1, lines 49 - 55

"The specific aim of the invention is to indicate to the player what are the best chances which he has of winning in a subsequent game, given the symbols or combinations of symbols which are displayed or which he has held." Col. 2, lines 39 - 43).

"... **the two aces are stored for the next game** or play and the computer unit 5 offers the player new game symbols only at positions 2, 3 and 5 in the next game, and these symbols may also include aces, thus to a greater or lesser extent improving the offered chances of winning." Col. 6, lines 43 - 47

"Normally the game proceeds by requiring the player to bet a certain amount of money for the first game and, if necessary, to bet a further certain amount of money for the subsequent game or play, although **in the second game or the subsequent section of the game, certain game symbols may have been predetermined by the first game.**" Col. 7, lines 45 - 51

“... the game symbols displayed or those selected by the player, especially the symbols selected for a next game, or on which a win is based, will be eliminated from the large number of predetermined game symbols of from the respective still available set of game symbols and will no longer be offered in any subsequent games.” Fuchs, Col. 3, lines 54 - 60.

5 Appellant submits that, given the other description set forth in Fuchs, that those skilled in the art would interpret Fuchs to provide (1) a game having an initial deal, (2) with the next game being played by holding/discarding the symbols of the initial deal, i.e., first game, to produce an outcome (game 1 outcome) and (3) a next game where the player can hold/discard symbols from the previous outcome (game 1 outcome) to, in essence “build” one or a series of outcomes. That
10 is, Fuchs does not carry over deck depletion to the next hand, as set forth in claim 37, but merely provides for deck depletion during the play of one hand, which may encompass a series of outcomes. Fuchs does not disclose or carry over deck depletion to the next hand. Fuchs states:

“Normally the game proceeds by requiring the player to bet a certain amount of money for the next game and, if necessary, to bet a further certain amount of money for the subsequent
15 game or play, although in the second game or the subsequent section of the game, certain game symbols may have been determined by the first game.” Fuchs, Col. 7, lines 46 - 51.

Given the other passages of Fuchs referred to above, it is submitted that those skilled in the art would interpret Fuchs to play a hand of play which encompasses a series of games where each subsequent game includes player held symbols from the previous game.

20 It is therefore respectfully submitted that Fuchs does not teach the carryover of depletion to subsequent hands as set forth in claim 37. Appellant also respectfully submits that the interpretation of Fuchs put forth by the Examiner is based upon impermissible hindsight of interpreting Fuchs to disclose or suggest depletion carryover when a fair reading of Fuchs does

not teach carryover.

Second, Examiner asserts that the teachings of Fuchs in the slot machine embodiment are readily translated to the card game embodiment. If the slot machine disclosure is as broad as Examiner interprets (which Appellant would assert it is not), and such a disclosure is readily
5 translated to a card game embodiment (which, again, Appellant would assert it is not), one must wonder why Fuchs did not disclose such a method in his disclosed card game. Appellant notes that deck depletion would have been a significant departure from conventional poker that Fuchs, if he was in fact doing so, would have addressed. The Board members are likely aware that in any poker game, whether video draw poker at a casino, Texas Hold ‘em on television, or a
10 friendly game at home, the deck is reshuffled after *every* hand and a continuously depleting deck is unheard of. Examiner states that it would have been known from conventional poker to use a deck as depleted by Fuchs. This is simply not the case.

Appellant submits that a much more reasonable interpretation of Fuchs is that the card game and slot game are, essentially, coextensive. This is supported by the claims which
15 generally claim a gaming machine in claim 1 and in dependent claims 6 and 8 recite slot (or “fruit”) symbols and cards, respectively, for display on the gaming machine. *Id.* at claims 1, 6, and 8. Fuchs slot game, then, is properly interpreted as a draw-type slot machine in which a hand consists of one or more phases in which symbols are discarded and replaced, where the replacements cannot include the discarded symbols. Properly read, Fuchs simply does not
20 disclose exclusion of played cards across separate and independent hands as recited in the claims.

In sum, to sustain Examiner’s rejection a number of questionable assumptions must be made. One must first assume that Fuchs discloses “deduction” of symbols across separate games. However, Fuchs himself indicates that deduction occurs in the context of related games

in which the player can “adjust his play” by holding or not holding certain symbols. Supposing that the first assumption can be made, one must also assume that the deduction in Fuchs is a complete exclusion. As noted, this is contradicted by Fuchs himself who states that symbols are reintroduced as needed to “ensure that an adequate number of game symbols is available at all times.” Supposing, contrary to Fuchs express statement, that the second assumption can also be made, one must further assume Fuchs can be applied to a card game, even though Fuchs himself *did not do so*. Appellant suggests that this chain of assumptions is simply too much to read into Fuchs.

Rather, Appellant submits that a much more reasonable interpretation of Fuchs is that a “hand” is conducted by spinning the reels, holding one or more of the symbols, respinning the reels with the previously displayed symbols deducted, holding one or more symbols, respinning, and so forth, with injections of additional symbols as needed. For each “new game,” the original stable is used brought back. This is clearly distinguishable from the claimed invention which uses continuously depleted deck across a sequence of games.

As the Board is well aware, Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to modify the reference teachings. The prior art reference (or references

when combined) must teach or suggest **all** the claimed limitations. MPEP §2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in the art. *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary skill in the art at the time the claimed invention was made, is not sufficient to establish *prima facie* obviousness without some objective reason to combine the teachings of the prior art. MPEP §2143.01. Further, if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. MPEP §2143.01.

Further there must be some showing of a motivation or teaching of the desirability of making the specific combination that forms the claimed invention. *In re Oetiker* 25 USPQ2d 1443 (Fed. Cir. 1992). This requirement cannot be satisfied by broad conclusory assertions since the same do not qualify as evidence. *In re Dembicziak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The Patent Office is not permitted to make assumptions as to basic knowledge simply alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as a substitute for the required production of evidence showing motivation. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001). The mere allegation of the existence of common knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002).

Appellant respectfully submits that the combination of Fuchs, Kinoshita, and Richardson fail to disclose or suggest inter-hand depletion or provide a motivation to alter the disclosed

intra-hand depletion across multiple games which each have a separate wager, deal, and outcome. Appellant respectfully requests reversal of the rejection of the group of claims represented by claim 23 which directly or indirectly recite this limitation or a substantially equivalent limitation.

5 2. Fuchs, Kinoshita, and Richardson Do Not Render Claim 23 Obvious
Because the References Fail to Show the Display of a Depleted Inventory.

Appellant further submits that Fuchs does not disclose or suggest the display of information to the player of elimination of any outcome as a result of depletion as set forth in claim 37. Fuchs discloses the display of possible outcomes based upon the player's hold decisions. The Examiner has taken the position that "One of ordinary skill in the art could thus say that the information is displayed regarding winning outcomes that have been eliminated." Final Office Action, page 8. However, Examiner is not permitted to make assumptions as to basic knowledge simply alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as a substitute for the required production of evidence showing motivation. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Appellant understands that Examiner has indicated that the feature of displaying the constituency of a depleted inventory is obvious in view of Fuchs, either alone or in combination with Kinoshita, U.S. Patent No. 5,967,894. That is, Examiner asserts that it would have been obvious to modify Fuchs, with or without the teachings of Kinoshita, to "display[] to the player information regarding any winning outcomes eliminated by said depletion of indica" as recited in the claims.

Fuchs, as discussed above, discloses displaying the status of the stable of symbols during a hand of play. That is, Fuchs shows a player which "symbols are therefore left over ... so that the player can adjust his game accordingly." Fuchs, col. 9, ll. 64-67.

As such, Fuchs shows intra-game deduction of symbols from the symbol stable. This was already discussed above and is understandable because draw poker is similarly conducted. However, since Fuchs does not show or suggest inter-game depletion, it cannot show intergame deck constituency, i.e. depletion impacting the “next hand of play,” as claimed.

5 The purpose of the display highlights this distinction. In Fuchs, the purpose of the display is “so that the player can adjust his game accordingly,” i.e. by deciding which symbols to hold for the upcoming spin. *Id.* Again, this is clearly directed to intra-game deduction. By contrast, the purpose of displaying deck constituency resulting from inter-game depletion is to (a) show the player that cards, in fact, are being depleted and (b) inform the player as to when
10 reconstitution may occur, or should be requested to occur in one claimed embodiment.

Examiner also cites to Kinoshita in rejecting the claims containing this claim limitation. Kinoshita does not disclose the display of deck constituency or even information impacting a “next hand of play” as claimed. Rather, Kinoshita discloses a gaming machine with an instructional display of the hands that could be formed by the player’s cards and the odds of
15 obtaining certain potential hands based on the cards held by a player. Kinoshita, col. 5, ll. 39–42. For example, a player with two pair will have a certain probability of obtaining a full house if the unmatched card is discarded and replaced. Conversely, the player will have no chance of obtaining, for example, a straight, if the two pair are held.

Appellant has trouble responding to this argument because Examiner has essentially
20 disposed of the distinction between displaying possible outcomes to showing deck constituency from preceding hands with the statement that “displaying cards over the hands is a design choice of one of ordinary skill in the art.” Appellant respectfully disagrees. Kinoshita discloses showing “a prize-winning hand which may possibly be achieved by the replacement of cards” in

the present hand. Kinoshita, col. 5, ll. 39–41. Fuchs shows the symbols remaining for replacement within the present hand. Neither of these references, however, make that leap to show the status of a depleted deck of cards based on the conduct and play of a *preceding* hand. As with Fuchs, Appellant suggests that Examiner is interpreting Kinoshita based on the teachings of Appellant’s disclosure rather than on its own terms and in its own context. Therefore, Appellant respectfully requests reversal of representative claims 23 and the group represented thereby which includes this claim limitation.

3. The Cited Art Neither Shows Nor Suggests Displaying a Table of Outcomes Excluding Outcomes Eliminated by Depletion.

Among the representative claims, claims 11 and 37 recite the display of outcomes excluding outcomes eliminated by intergame deck depletion. Examiner asserts that Fuchs, in combination with Kinoshita, discloses such a feature.

Let us not lose sight of what Fuchs and Kinoshita disclose. Fuchs displays to the player the replacement symbols available so that “the player can judge which game symbols he should keep for a subsequent game, if he wants to keep any at all” Fuchs, col. 9, ll. 41–46. In other words, Fuchs shows the state of the symbol stable as a result of intragame deduction. Kinoshita displays “already achieved prize-winning hands,” “a possible prize-winning hand ... and the corresponding odds,” and “impossible prize winning hands” based on the cards dealt and held. Kinoshita, col. 7, ll. 16–30. In other words, Kinoshita shows the hands attainable as a result of the cards held.

Examiner asserts that Kinoshita shows the exclusion of outcomes and this is true. Kinoshita shows altering the display of a list of outcomes based on the cards held in a player hand. For example, if two pair are held, two pair (as an achieved outcome) and full house (as a possible outcome) are highlighted while other outcomes, such as straight flush, are dimmed.

Kinoshita, col. 7, ll. 31–62.

However, this is not what is recited in the claims. The claims recite the exclusion of outcomes eliminated as a result of deck depletion that impacts the next hand of play before the next hand is played. In fact, neither cited reference shows a table of outcomes excluding

5 outcomes eliminated as a result of deck depletion from preceding hands. It is only logical that if neither reference shows deck depletion from preceding hands, they cannot show a table of outcomes that excludes outcomes not attainable as a result of deck depletion from preceding hands.

To the contrary, these references show elimination of possible outcomes caused by player
10 choice, which is well known in the art. It is axiomatic that if a player holds certain cards, certain outcomes become unavailable on the draw. This is not due to deck depletion, but simply the play of the game which uses only five cards. If a player holds a pair of 4s, he/she cannot get a Straight Flush, Royal Flush, four Aces, Straight or Flush simply because the holding of the pair of 4s makes these outcomes unavailable. They have not been eliminated by depletion. The
15 outcomes have been eliminated by player choice.

Even accepting, for the sake of argument, Examiner's position that Fuchs and Kinoshita could be combined, that combination would not give the claimed game. Without regard to whether Fuchs discloses deck depletion, and Appellant would assert that it does not, Kinoshita still only shows a display of outcomes based on the player's holding, *not* on the constituency of
20 the deck. Kinoshita constructs a display based on the holding of X cards, that the player has A outcome already obtained, could possibly obtain B outcome, and cannot obtain C outcome. This does not tell the player whether, for example, the deck constituency could support Royal Flush or four Aces as recited in the claims. It would only tell the player that if he holds a pair of nines, he

cannot obtain a Royal Flush or four Aces.

Again, Examiner's argument requires the assumption to be made that in applying Kinoshita to Fuchs, Kinoshita's table *which is explicitly based on the cards held* would be altered *so that it is no longer based on the cards held*. This, is contrary to the M.P.E.P. which directs
5 that if a proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. M.P.E.P. section 2143.01.

Even accepting that Kinoshita can be altered to operate in a manner contrary to Kinoshita's express teaching, one must further assume that the altered form of Kinoshita would
10 be based on outcomes that can be formed based on deck constituency rather than some other form. This, too, is a leap since neither Kinoshita nor Fuchs shows or suggests a table of outcomes based on deck constituency let alone a table of outcomes that excludes certain outcomes resulting from deck depletion. Certainly, it is possible to make this leap in view of Appellant's teachings and Appellant would suggest that this is what Examiner has done in her
15 rejection. However, Appellant respectfully suggests that a motivation to make such a modification cannot be found in the cited art.

In sum, Kinoshita and Fuchs fail to disclose or suggest a table of outcomes in which the table is based on deck constituency and excludes outcomes that are unavailable as a result of deck depletion across games. This arises primarily from the fact that neither Kinoshita or Fuchs
20 shows or suggests deck depletion across games. However, regardless of whether Kinoshita or Fuchs shows deck depletion across games, neither reference shows or suggests the construction of an outcome table based on deck constituency.

In fact, Fuchs teaches away from this feature by providing:

“In order to ensure that an adequate number of game symbols is available at all times, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, **the number of available game symbols can be added to in a random fashion or predetermined fashion...**” Col. 10, lines 1–6.

5 Thus, Fuchs ‘753 teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning outcome. Appellant, on the other hand, lets depletion occur even to the point where certain outcomes become eliminated.

 Further, displaying the probabilities of obtaining a winning outcome, as disclosed in Fuchs, is vastly different from displaying the outcomes which have been eliminated as a result
10 of depletion. Even if Fuchs permitted depletion to eliminate certain outcomes (which it does not), the player would have to have a certain starting set of symbols AND make certain hold decisions to generate a display that the probability of obtaining an outcome is “zero.” Any eliminated outcomes would only become known based upon (1) the cards dealt to the player and (2) the player’s hold decisions. That is, if the player were dealt a hand of 7♥ 4♣ 9♠ 4♦ 2♦ in
15 Fuchs he would have no way of knowing if the Royal Flush has been eliminated since none of the hold decisions would prompt Fuchs to display this information in that there are no cards in the initial holding which could be included in a Royal Flush. Further, if the player decides not to hold any cards of the initial holding, Fuchs again would not display which outcomes have been eliminated. For example, with the hand of 7♥ 4♣ 9♠ 4♦ 2♦ and the player decides to hold
20 none of the cards, NO information would be imparted to the player whether any fours of a kind, straight flushes, straights, full houses or the like have been eliminated due to inventory depletion. In Fuchs, the player must make a hold decision before any information is imparted to the player. Where, as in the present invention according to certain claims, the player has the option of

commanding reshuffling, information as to which outcomes cannot be obtained due to depletion (regardless of any hold decisions the player may make) can be useful to the player in their strategy as to whether or not command re-shuffling. The invention of claim 23 does not require any initial holding of cards or any player action (holding cards) to display that, for example, any
5 Royal Flush has been eliminated as a result of depletion. Rather, it merely displays the outcomes depleted before play of the next game in a series of games.

It is respectfully submitted that, based upon the foregoing, any interpretation that Fuchs displays information as to which outcomes have been eliminated is based upon impermissible hindsight.

10 The Examiner has also cited Kinoshita for showing the feature of the displaying of information for any outcomes which have been eliminated by depletion. This reference suffers from the same deficiencies as Fuchs. Kinoshita does not disclose or suggest deck depletion and, as a result, no outcome of this reference is eliminated as a result of depletion. Kinoshita does show which outcomes of a pay table are unavailable as a result of which cards the player decides
15 to hold (like Fuchs). The Examiner has referenced FIGS. 8(a) and (b) in support for her position. However, these drawings and the description of Kinoshita do not support a conclusion that (1) outcomes are eliminated by depletion and (2) that information of eliminated outcomes is imparted to the player. In Kinoshita FIG. 8(a) all pay table combinations are available (none have been eliminated). Thus if the player choose not to hold any of the cards of the initial
20 holding and replace all the cards, a Royal Flush is still available. According to the present invention, if the Royal Flush (or any other possible winning outcome) has been eliminated through depletion (for example all of the Kings have been depleted by prior hands), that information would be displayed to the player so that he/she would know that no matter what the

hold decision may be, depletion has eliminated any possibility that than outcome can be obtained.

In sum, Appellant respectfully submits that the cited art fails to show depletion across separate and independent hands played from a single finite inventory. Moreover, the cited references fail to show the display of a depleted inventory or outcomes eliminated as a result of depletion. Appellant's argument is partly a logical argument, i.e. the cited art cannot show a display of an inventory depleted across a series of hands if the cited art fails to show depleting an inventory across a series of hands. But Appellant's argument is also grounded squarely in the references themselves which never disclose or suggest the claimed features. Rather, the cited references must be read with a strained interpretation with a series of unsupportable assumptions to find the recited features. Therefore, Appellant respectfully requests reversal of Examiner's rejection of claim 23 and the group of claims represented thereby.

B. Group 2 Claims

1. Claim 26 is Allowable Over the Cited References Because Fuchs, Kinoshita, and Richardson Fail to Disclose or Suggest Reconstitution of a Depleted Inventory.

Representative claim 26 recites reconstitution of a depleted deck. Examiner has asserted that this claim limitation is shown by the combination of Fuchs, Kinoshita, and Richardson, U.S. Patent No. 5,042,809. However, Examiner relies primarily on Richardson to stand for the proposition that deck reconstitution is known.

In the Office Actions, Examiner strayed from the central question of whether Richardson shows deck reconstitution. It simply does not.

Richardson discloses a pull tab terminal. The characteristic of a pull tab terminal, as distinguished from a slot machine, is that a predetermined quantity of winning tickets is

guaranteed. That is, among the X tickets loaded into the machine, there will be, with absolute certainty, Y winning tickets. In a slot machine, by contrast, each pull has Z probability of being a winning outcome, but there is no guarantee that X pulls will produce Y winning outcomes.

In Richardson, a quantity of tickets are dealt from an inventory of tickets. In the example
5 given, nine tickets are dealt. Richardson, col. 6, ll. 62–67. Players select tickets and selected tickets are revealed. *Id.* at col. 11, ll. 37–45. If a player wishes to refresh the display, a “New Deal” order causes nine new tickets to be dealt. *Id.* at col. 11, ll. 49–52. The previously revealed tickets are retired and unrevealed tickets are returned to the inventory. Once an insufficient quantity of tickets exists to deal nine tickets to the display, the game is retired. *Id.* at col. 12, ll.
10 59–62. That is, *the ticket inventory is not reconstituted*. To the contrary, “[i]f a game is retired, the player can choose another game from the master game screen, or call the operator, or quit.” *Id.* at col. 12, ll. 62–64 (internal reference numbers omitted). Reconstitution is simply not an option, whether at the player’s demand or automatically upon the occurrence of a certain event.

Examiner has asserted that Richardson allows for “reconstituting a dead inventory.” This
15 is simply not the case. Richardson does allow for discarding unexposed tickets and receiving a new deal of tickets. *Id.* at col. 11, ll. 47–49. This would be analogous to, for example, folding in a card game by discarding a hand and obtaining a new hand. The inventory of tickets, analogous to the deck of cards, however, cannot be reconstituted. *Id.* at col. 12, ll. 62–64. This is logical because the advantage of pull tab terminals is the predictability of the quantity of winners. If the
20 player were allowed to reconstitute the inventory at will, the quantity of winners would be wholly unpredictable.

In sum, Richardson fails to disclose or suggest the reconstitution of an inventory. In fact, Richardson explicitly states that when an inventory is dead, the game is retired and cannot be

played. Since Richardson neither discloses nor suggests the reconstitution of an inventory of cards upon demand or upon occurrence of an event, Appellant respectfully submits that Examiner's rejection of representative claims 26, which contain such claim limitations, must be reversed.

5 C. Group 3 Claims

1. Claim 24 and the Group Represented Thereby Are Not Obvious in View of Fuchs, Richardson, and Kinoshita Because None of the Cited References Disclose or Suggest Randomly Ordering an Inventory and Serially Dealing from the Ordered Inventory Across a Series of Games.

10 Claim 24 recites the feature of means for randomly arranging said playing card data into random serial order. As described in the specification, this feature randomizes the card data, e.g. cards, and arranges the data into a serial structure N_1-N_{52} , for example, representing a randomized deck of fifty-two cards.

15 The Examiner has rejected claim 24 as being obvious over Fuchs in view of Kinoshita. The Examiner's position is that it would be obvious for one of ordinary skill in the art that the symbols could be accessed randomly from the list data structure and then accessed serially. The Examiner has not cited any reference or evidence in support of this position. Neither Fuchs or Kinoshita disclose or suggest this feature.

20 Reversal of the rejection of this claim and the claims represented thereby is requested.

Conclusion

It is respectfully submitted that the cited references fail to render the pending claims obvious. Appellant respectfully submits that the cited art has been misinterpreted and certain
25 assumptions regarding the disclosures made therein are simply not supported by the references themselves. In fact, the cited references would have a completely different meaning to one of


ordinary skill in the art than the meaning ascribed to the references in the rejections. Simply put, however, the cited references fail to disclose or suggest depleting a finite inventory across separate and distinct games which each terminate with an outcome. Rather, the cited references only show depletion within a game prior to an outcome for that game. Additionally, the cited references fail to disclose or suggest displaying a depleted inventory from game to game and outcomes depleted from game to game. Again, the cited references can only be interpreted to disclose the display of outcomes unavailable due to player selection, not inventory depletion. Finally, the cited references fail to show constituting a finite inventory for serial traversal.

Appellant respectfully requests that the rejections as to all claims be reversed.

Respectfully submitted,

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APPENDIX - PENDING CLAIMS

7. The method of claim 23 comprising reconstitution of the inventory to X when a predetermined number of indicia remain in said inventory.

5

8. The method of claim 23 comprising randomly selecting and displaying indicia by arranging said indicia into a random, serial order of 1 - X and selecting and displaying said indicia in order from said arranged inventory.

10 12. The device of claim 26 comprising said processor configured to select and display a matrix of indicia, said matrix including a plurality of pay lines each including an outcome, means for the player to wager on a plurality of said pay lines and said processor configured to compare the outcome for each wagered upon pay line to said schedule and to issue an award for each winning combination.

15

14. The device of claim 12 comprising said processor configured to arrange said inventory into a random serial order 1 - X, to serially select and display said indicia from said arranged inventory.

20 15. A method for playing a wagering game using an inventory of indicia, said inventory when fully constituted having X number of indicia arranged in sets of at least two indicia each, the method comprising:

a player making a wager to play each of a series of hands;

for each hand of play, randomly selecting and displaying a plurality of individual indicia

from the inventory, the combination of indicia selected and displayed defining at least one hand outcome and depleting said selected indicia from play for subsequent hands;

comparing said hand outcome to a predetermined schedule of winning outcomes and if said hand outcome matches one of said schedule of winning outcomes, issuing an award to the

5 player; and

prior to play of the next hand displaying the number of each indicia remaining in each indicia set in the inventory as depleted and displaying any scheduled winning outcomes eliminated as a result of depletion of said indicia inventory.

10 16. The method of claim 15 comprising the player (i) making another wager to play a hand using the depleted inventory or (ii) commanding reconstitution of the inventory to X prior to the play of the next hand.

17. The method of claim 15 comprising reconstitution of the inventory to X when a
15 predetermined number of indicia remain in said inventory.

18. The method of claim 15 comprising randomly selecting and displaying indicia by arranging said indicia into a random, serial order of 1 - X and selecting and displaying said indicia in order from said arranged inventory.

20

19. An electronic device for a player to play a game utilizing an inventory of X game indicia arranged in sets of at least two indicia each, the device comprising:

a computer processor storing data corresponding to said inventory;

a video display;

means for a player to make a wager and prompt play of the game;

said processor, in response to said prompt, configured to randomly select and display at said display a combination of individual indicia selected from said inventory of indicia, said

5 selected and displayed indicia combination defining at least one outcome, said processor configured to remove said selected indicia from selection for future hands;

said processor configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure, to issue an award for each selected and displayed winning outcome, to control the display to display prior to the play of the next hand data

10 corresponding the remaining inventory of indicia sets depleted of said displayed game indicia including the display of data corresponding to the depletion of indicia from said inventory such that one or more scheduled winning outcomes are unavailable due to depletion and said processor configured to, for the next hand of play, select indicia from the depleted inventory.

15 20. The device of claim 19 comprising input apparatus for the player to input a re-shuffle signal to said processor to prompt the processor to reconstitute said indicia inventory to X.

21. The device of claim 19 comprising said processor configured to select and display a matrix of indicia, said matrix including a plurality of pay lines each including an outcome, means
20 for the player to wager on a plurality of said pay lines and said processor configured to compare the outcome for each wagered upon pay line to said schedule and to issue an award for each winning combination.

22. The device of claim 19 comprising said processor configured to arrange said inventory into a random serial order 1–X, to serially select and display said indicia serially from said arranged inventory.

5 23. A method for playing a wagering game using an inventory of indicia, said inventory when fully constituted having X number of individual indicia, the method comprising:

- a player making a wager to play each of a series of hands;
- for each hand of play, randomly selecting and displaying a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a
- 10 winning or losing outcome for the hand and depleting said displayed individual indicia from the inventory available for play of the next hand;
- for a winning outcome, issuing an award to the player;
- prior to the commencement of the next hand of play displaying to the player information regarding any winning outcomes eliminated by said depletion of indicia; and
- 15 the player (i) making another wager to play a hand using the depleted inventory.

24. A method for playing a wagering game using an inventory of indicia, said inventory when fully constituted having X number of indicia arranged in indicia sets of at least two indicia each, the method comprising:

- 20 a player making a wager to play the game;
- arranging the inventory into a random serial order 1–X;
- serially selecting and displaying a plurality of individual indicia from the inventory, the combination of selected and displayed individual indicia defining a winning or losing outcome

and depleting said displayed indicia from the inventory available for play of subsequent hands;
for a winning outcome, issuing an award to the player;

prior to play of the next hand displaying to the player any winning outcomes eliminated
by depletion of the indicia and the number of each indicia remaining in each indicia set in the

5 inventory as depleted of the prior selected and displayed inventory; and

the player (i) making another wager to play the game using the depleted inventory or (ii)
commanding reconstitution of the inventory to X prior to the play of the next game.

25. A method for playing a wagering game using an inventory of indicia sets, said inventory

10 when fully constituted having X number of indicia, the method comprising:

a player making a wager to play the game;

for each hand of play, randomly selecting and displaying a plurality of indicia from the
inventory into the coordinates of a game matrix, the combinations of indicia in the game matrix
defining a plurality of winning or losing outcomes and depleting said displayed indicia from the

15 inventory available for play of subsequent hands;

for each winning outcome, issuing an award to the player;

prior to play of a subsequent hand, displaying the number of each indicia remaining in the
sets in the inventory as depleted of the prior selected and displayed inventory and any winning
outcomes eliminated as a result of depletion; and

20 the player opting to (i) make another wager to play a next game using the depleted
inventory or (ii) commanding reconstitution of the inventory to X prior to the play of the next
game.

26. An electronic device for a player to play a game utilizing an inventory of X game indicia, the device comprising:

a computer processor storing an arrangement of said inventory;

a video display;

5 means for a player to make a wager and prompt play of the game;

said processor, in response to prompting, configured to randomly select and display at said display indicia selected from said inventory of indicia, a plurality of selected and displayed indicia defining an outcome and to preclude said selected indicia from selection from said inventory;

10 said processor configured to compare said outcome to a schedule of winning outcomes stored in a data structure, to issue an award for a winning combination and to control the display to display prior to play of the next hand any scheduled winning outcomes eliminated by depletion of said indicia; and

means to prompt the processor to reconstitute said indicia inventory to X.

15

27. The device of claim 26 comprising said prompting means comprising said processor configured to reconstitute the inventory to X when a predetermined number of indicia remain in said inventory.

20 28. The device of claim 26 comprising said prompting means comprising means for a player to input a prompt to the processor to reconstitute the inventory to X.